

REMARKS/ARGUMENTS

Claims 1-9 are pending in the present application. Claims 7 and 8 have been withdrawn and claims 2, 3, 4 and 9 have been cancelled. Claim 10 has been added. The Examiner has requested that the status and accuracy of the parent application be updated. Upon review of the parent files, they both have allowable subject matter; however, neither has matured into a patent and thus, the application cannot be updated at this time. The disclosure is objected to because of several informalities, all of which have been corrected including a change to Fig. 6. The drawings were objected to under 37 C.F.R. 1.83(a) as they do not show every feature of the invention specified in the claims. Consequently, Applicant has added a new Fig. 8 that shows the method of claim 1 with each step in a box. Each step is taken directly from claim 1. Additionally, a paragraph has been added to the specification describing this figure by reciting the method set forth in claim 1. Thus, no new matter has been added to the application and the drawing objection regarding claim 1 is considered overcome. Claim 9 has been cancelled and this drawing objection has also been considered overcome.

The specification has been objected to as failing to provide proper antecedent basis for the claimed subject matter. Consequently, claims 3 and 9 have been cancelled and the specification has been amended to include the limitations set forth in claims 1, 4 and 6. Again, all added language to the specification is a recitation of claim language in claims 1, 4, and 6. Therefore, no new matter has been added.

Claims 1-6 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way to enable one skilled in the art to which it pertains, or with which it is

most nearly connected to make or use the invention. Claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's submitted prior art in Palmer (U.S. Pat. No. 5,507,501). Claim 9 has been cancelled. Claim 1 and 2 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Ball (U.S. Pat. No. 5,890,241 hereinafter Ball '241) and Palmer. Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball and Palmer as applied above and further in view of Ball (U.S. Pat. No. 5,745,931 hereinafter Ball '931). Claim 3 has been cancelled. Claims 4-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball '241 and Palmer as applied to claim 1 above and further in view of Francisco (U.S. Pat. No. 6,088,843). Applicant respectfully traverses all rejections.

Claims 1-6 and 9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most clearly connected, to make and/or use the invention. For a rejection by the Examiner based on a lack of enablement requirement, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See MPEP 2164.04. Specifically, when rejecting a claim under the enablement requirement of section 112, the Examiner bears the "initial burden of setting forth a reasonable explanation as to why [he/she] believes that the scope of protection provided by [the] claim is not adequately enabled by the description of the invention provided in the specification." In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). To object to a specification on the grounds that the disclosure is not enabling with the respect

to the scope of the claim sought to be patented, the Examiner must provide evidence or technical reasoning sustaining those doubts. Id; and MPEP 2164.04. Without a reason to doubt the truth of the statements made in the patent application, the application must be considered enabling. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Accordingly, the case law makes clear that properly reasoned and supported statements explaining any failure to comply with section 112 are a requirement to support a rejection. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Applicant submits that the Examiner has not provided proper support that the Applicant's specification is not enabling. To make the 112 rejection, the Examiner has stated "Implementation of this [placing a thin diaphragm over the waste water port and charging the primary drain system with fluid] subject matter is neither taught by the instant disclosure nor evident to the Examiner. Merely placing a diaphragm over the drain port would not be sufficient to prevent water leakage when the drain system is charged with water." (Office action, pages 4-5). Claim 1 has been amended to require sealing a diaphragm over a drain port. This amendment makes the claim language consistent with the specification to further ensure the specification is enabling.

Furthermore, the Examiner has not provided any evidence that should cause the Examiner to doubt the truth of the statements made in the patent application. Nor has the Examiner provided evidence that one skilled in the art would not understand how to place a diaphragm as described and shown in the figures over a drain port and how to charge water within the system. Thus, the Examiner has not established a *prima facie*

case for lack of enablement and the rejection must be withdrawn. Claims 4-6 depend on claim 1 and are also considered enabled.

Independent claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball '241 and Palmer. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 has been amended to add the limitation of claim 2 that states "wherein the diaphragms are opened by physically cutting them open to permit fluid flow." Neither reference requires a step of opening diaphragms by physically cutting both the overflow port diaphragm and the waste water port diaphragm to permit fluid flow. Instead, as admitted by the Examiner, the '241 drain system does not include a diaphragm in the waste water port. (Office action, page 6). The Palmer device teaches to remove sealing disk 10 lug 30 is pulled in a continuous point action so as to rip the circular disk 12 along grooves 40 and 42 in a generally spiral ripping motion that tears the circular disk 12 into an elongated spiral strip. (Col. 5, lines 25-29). Thus, Palmer does not teach cutting into a waste water port diaphragm and instead teaches ripping or tearing a circular disk. Therefore, each and every limitation of the amended claim 1 is not present and the obviousness rejection must be

withdrawn. Claims 4-6 depend on claim 1 and for at least this reason are considered in allowable form.

New claim 10 has been added to the application. New claim 10 in part requires "detachably engaging a cap to the lug to cover the nut." None of the prior art references cited to Palmer, Ball '241, or Ball '931 teach a cap that is detachably engaged to the lug of a nut in order to cover the nut. Thus, the new claim is considered novel and non-obvious in view of the cited prior art and Applicant respectfully requests allowance.

#### CONCLUSION

In view of the above remarks, Applicant believes that claims 1, 4-6, and 10 are in condition for allowance and Applicant respectfully requests allowance of such claims.

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



Timothy J. Zarley  
Reg. No. 45,253  
ZARLEY LAW FIRM, P.L.C  
Capital Square  
400 Locust Street, Suite 200  
Des Moines, IA 50309-2350  
Phone No. (515) 558-0200  
Fax No. (515) 558-7790  
Customer No. 34082  
Attorneys of Record

- JJL/bjs -

**Amendments to the Drawings:**

The attached sheet of drawings includes changes to Fig. 6 and new Fig. 8. This sheet, which includes Fig. 6, replaces the original sheet including Fig. 6. In Fig. 6, element 28 was changed to element 29. New Fig. 8 was added and shows a flow chart of a method of conducting a fluid leakage test.

Attachment: Replacement Sheet  
Annotated Sheet Showing Changes



**Application No. 10/732,726  
Reply to Office Action dated May 23, 2005  
Annotated Sheet Showing Changes**

